

REMARKS

Claims 1-23 are pending. In the present amendment, Applicants have amended claims 1-3, 10, 12-15, 17, and 21 to recite alternative Markush language. In addition, Applicants have amended claim 22 to recite, "A method of producing a lactone comprising culturing *Candida sorbophila* in a medium." Support for that amendment is found, for example, in original claim 1 and in the Specification, at least at page 4, lines 21-26. Applicants also amended claim 23 to recite, "An isolated *Candida sorbophila* strain FERM BP-8388," as is supported by the specification, for example in the paragraph bridging pages 9-10.

Thus, no new matter is added by this amendment.

RESPONSE TO RESTRICTION REQUIREMENT

Applicants now respond to the Restriction Requirement in the Office Action dated November 15, 2005.

In the Restriction Requirement, the Examiner required restriction under 35 U.S.C. §§ 121 and 372 between the following groups:

Group I: claims 1-12 and 14-21, drawn to a method of producing a lactone comprising culturing *Candida sorbophila*.

Group II: claim 23, drawn to a *Candida sorbophila* strain BP-8388.

Group III: claim 13-49 whereby the product is drawn to a recovered precursor.

The Examiner noted that Claim 22 is a non-statutory claim which cannot be properly classified as to a product, composition or process claim.

The Examiner noted that under the M.P.E.P. §§ 806.05(h), the inventions are distinct from each other because:

Inventions II or I and III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product.

Office Action at page 3.

The Examiner stated that:

Inventions [sic] III is drawn to a distinct product than that of Invention I. []
In addition, Invention I does not require the specifics of Invention II.
Invention I does not require the specifics of Invention III.

Id.

The Examiner also stated that:

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different components obtained or used, have acquired a separate status in the art because of their recognized divergent subject matter and the search required for one invention is not required for the other invention, thusly the restriction for examination purposes as indicated is proper which above distinctions would be extremely burdensome to search and examine all of the inventions as well as the species as noted in the following paragraph.

Id.

Applicants respectfully traverse. First, Applicants note that the Examiner did not indicate the class and subclass for the respective groups. Accordingly, the Examiner has not demonstrated that a search would necessitate examining different subclasses. Thus, there is no indication that there would be an undue burden to search the subject matter of all these claims. Moreover, Applicants specifically note that Group II (claim 23) can be readily examined together with Group I (claims 1-12 and 14-21) because the strain BP-8388 of claim 23 is *Candida*

sorbophila and *Candida sorbophila* is expressly recited in each independent claim of Group I (claims 1, 2, 14, 15, 18, and 19).

Thus, any search for provisionally elected Group I would also cover the art relevant to Group II. Thus, Applicants respectfully request that the Examiner withdraw the Restriction Requirement with respect to Groups I and II.

Nonetheless, to comply with the Restriction Requirement, Applicants provisionally elect with traverse Group I, claims 1-12 and 14-21, drawn to a method of producing a lactone comprising culturing *Candida sorbophila*. Further, with respect to election of species requirement, Applicants provisionally elect as follows:

- A: A3 hydrolysate of a fatty acid derivative;
- B: Bx directly from the medium;
- C: Cii glyceride of hydroxy fatty acid;
- D: Da Castor oil or castor oil hydrolysate; and
- E: E1 in the medium without any recovery of the lactone precursor.

Applicants also provisionally elect to prosecute claim 22 (characterized by the Examiner as a non-statutory claim) in this application. As noted in the Amendments to the Claims and Remarks section of this paper, Applicants have amended the claim to properly reflect U.S. patent practice. The right to pursue non-elected subject matter in one or more divisional applications is expressly reserved.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account No. 06-0916.

Respectfully submitted,

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